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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,346	03/26/2004	Russell Bonaventura	LEAP:128US	1571

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EXAMINER
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PRITCHETT, JOSHUA L

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/811,346

Applicant(s)

BONAVENTURA ET AL.

Examiner

Joshua L. Pritchett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-7, 9-13 and 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-7, 9-13 and 15-21 is/are allowed.
- 6) ☒ Claim(s) 22-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to Request for Continued Examination and Amendment filed November 16, 2006. Claims 1, 5, 6, 11-13, 15-17, 19, 22 and 27 have been amended claim 14 has been cancelled and claims 33 and 34 have been added as requested by the applicant.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 24, 26-28, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esmay (US 4,616,517) in view of Ganser (US 5,684,627).

Regarding claim 22, 26, 28 and 32, Esmay teaches a focusing means comprising a removable focus adjustment knob (20) and a focus drive means (22). Esmay further teaches the first and second focus drive means has a planar outer surface that the first and second removable focus adjustment knob is removably attached (col. 3 lines 66-68; Fig. 1). The end face of the shaft is planar and attaches to the focus adjustment knobs. The claim language does not require the first and second drive means be separate therefore the Esmay invention meets the claimed

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limitations. Esmay lacks reference to the focus adjustment means provided on opposite sides of the microscope. Ganser teaches it would be advantageous to place duplicate focus adjustment means on opposite sides of a microscope body for ergonomic purposes (col. 3 lines 65-66). Esmay further lacks the axial length of one focus knob being longer than another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to change the axial length of one of the focus knobs, since such a modification would involve only a mere change in size of a component. Scaling up or down of an element which merely requires a change in size is generally considered as being within the ordinary skill in the art. There appears to be no substantial advantage to having one knob longer than the other except for design choice or user preference. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Esamy microscope include the focus means on opposite sides of the microscope as taught by Ganser for the purpose of allowing easy operation by a person with either hand being dominant.

Regarding claims 24 and 30, Esmay teaches the use of pin means extending axially of the removable focus adjustment knob and pin receiving means (113) complementarily extending axially of the focus drive means (Fig. 1).

Regarding claim 27, Esmay teaches a focus means comprising a first coarse (16) and first removable (20) focus adjustment knobs and a drive means (22). Esmay further teaches the first and second focus drive means has a planar outer surface that the first and second removable focus adjustment knob is removably attached (col. 3 lines 66-68; Fig. 1). The end face of the shaft is planar and attaches to the focus adjustment knobs. The claim language does not require the first and second drive means be separate therefore the Esmay invention meets the claimed

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limitations. Esmay lacks reference to the focus adjustment means provided on opposite sides of the microscope. Ganser teaches it would be advantageous to place duplicate focus adjustment means on opposite sides of a microscope body for ergonomic purposes (col. 3 lines 65-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Esmay microscope include the focus means on opposite sides of the microscope as taught by Ganser for the purpose of allowing easy operation by a person with either hand being dominant.

Regarding claim 33, Esmay teaches the first focus drive means has a first rotatable shaft attached to the planar outer surface opposite the first removable fine adjustment knobs, and a second rotatable shaft associated with the first coarse adjustment knobs (Fig. 1). The claim does not require the first and second rotatable shafts are different. Esmay lacks reference to the focus adjustment means provided on opposite sides of the microscope. Ganser teaches it would be advantageous to place duplicate focus adjustment means on opposite sides of a microscope body for ergonomic purposes (col. 3 lines 65-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Esmay microscope include the focus means on opposite sides of the microscope as taught by Ganser for the purpose of allowing easy operation by a person with either hand being dominant.

Regarding claim 34, Esmay teaches the first focus drive means has a first rotatable shaft attached opposite to the planar outer surface on the opposite side that the first removable focus adjustment knob is removably attached, and a third rotatable shaft is associated with the first coarse adjustment knob (Fig. 1). The claim does not require the first through fourth shafts are different. Esmay lacks reference to the focus adjustment means provided on opposite sides of

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the microscope. Ganser teaches it would be advantageous to place duplicate focus adjustment means on opposite sides of a microscope body for ergonomic purposes (col. 3 lines 65-66).

Ganser in combination with Esmay therefore teaches a second focus drive means has a second rotatable shaft attached to the planar outer surface on the opposite side that the second removable focus adjustment knob is removably attached, and a fourth rotatable shaft is associated with the second coarse adjustment knob. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Esmay microscope include the focus means on opposite sides of the microscope as taught by Ganser for the purpose of allowing easy operation by a person with either hand being dominant.

Claims 23, 25, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esmay (US 4,616,517) in view of Ganser (US 5,684,627) as applied to claims 22 and 27 above, and further in view of Bigelow (US 4,158,216).

Esmay in combination with Ganser teaches the invention as claimed but lacks reference to magnetic attachment. Bigelow teaches a knob (20) magnetically attachable to maintain the position of the knob (Fig. 2; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the knob of Esmay in combination with Ganser attachable using magnetic attraction for the purpose of providing a more secure attachment to the focus adjustment means so that the knob would not easily fall off the microscope.

### ***Response to Arguments***

Applicant's arguments, see Amendment, filed November 16, 2006, with respect to claims 1, 5 and 12 have been fully considered and are persuasive. The rejection of claims 1, 5 and 12 has been withdrawn. Applicant amended the claim language to overcome the prior art of record.

Applicant's arguments filed November 16, 2006 have been fully considered but they are not persuasive.

Applicant argues the prior art fails to teach or suggest the first removable focus adjustment knob is attached to a planar outer surface. The claim language requires a removably attached knob and a planar surface, not attachment to the planar surface. Still, the knob of Esmay is attached to the shaft which has the planar surface on its end and therefore the knob is attached to the planar surface.

Applicant argues the combination of Esmay and Ganser fails to teach the focus adjustment knob alternatively fastenable to either the first and second focus drive means. Ganser teaches the placement of a duplicate focusing assembly on opposite sides of a microscope. If the focusing assembly on one side is the same as the focusing assembly on the other side then the knobs would be interchangeable.

Applicant argues the knobs taught in Esmay would be substantial to create an interchangeable knob. The claim language does not require the fine focus knob be interchangeable with the coarse focus knob. The claim language allows for an interpretation where the fine focus knob on one microscope is interchangeable with the fine focus knob on another microscope, or on the opposite side of the microscope.

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Applicant argues the Esmay and Ganser reference fail to teach the focus adjustment knob with greater axial length than the other. It has been held that changes in size are within the skill of one of ordinary skill in the art. It is obvious to make something larger or smaller depending on the preference of the user.

Applicant argues Esmay fails to teach a pin extending axially from the removable focus adjustment knob. The claims do not say “axially”. That allows the pin means to be the fastening shaft and the pin receiving means to be the bore (113) that accepts the shaft.

***Allowable Subject Matter***

Claims 1-3, 5-13 and 15-21 are allowed.

The following is an examiner’s statement of reasons for allowance:

Regarding claims 1 and 5, the prior art fails to teach or suggest the focus knob magnetically fastenable to the planar outer surface of the focus adjustment means in a manner that prevents axial direction separation during rotational movement and enables slippage when the upper and lower limits of the focusing are reached as set forth in claims 1 and 5.

Regarding claim 12, the prior art fails to teach or suggest the focus adjustment adjustment knob and the removable focus adjustment knob are independently rotatable at the same time and the removable knob is attachable to the left and right side of the microscope as set forth in claim 12.

The remaining claims depend from claims 1, 5 and 12 and are allowable for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joshua L Pritchett  
Examiner  
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